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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

IN RE APPLICATION TO REISSUE
U.S. PAT. NO. 4,912,155,
ISSUED MARCH 27, 1990

SERIAL NO.

FILED APRIL _____, 1991

FOR ANTIOXIDANT AROMATIC FLUORO-
PHOSPHITES

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DECLARATION OF J.D. ODENWELLER UNDER 37 C.F.R. 1.175 (b)

Honorable Commissioner of Patents and Trademarks
Washington, D.C. 20231

Dear Sir:

I, Joseph D. Odenweller, hereby declare:

1. I am the patent attorney who filed application Serial No. 20,023 which issued March 27, 1990 as U.S. 4,912,155. I had been employed by Ethyl Corporation as a patent attorney for a number of years when I retired March 31, 1990.

2. I understand that the inventor and the assignee of the Patent are filing an application to reissue the above Patent, and in the paragraphs below I set forth the facts specifying how and when certain errors occurred.

3. At the outset, it must be explained that the general origins of the errors were the unfortunate changes in the attorneys responsible for the patent application, which were not the fault of the applicant or assignee.

4. The original application specifications were prepared by a patent attorney for Ethyl Corporation ("Ethyl") Edward Scherer. On September 1, 1986, Mr. Scherer left Ethyl on short notice and took a position with another company. Thereafter, I inherited Mr. Scherer's docket, and, therefor, for a time had to carry an overloaded patent prosecution docket in addition to my other duties as Group Patent Counsel for the Ethyl Chemicals Group. The draft application papers for the above patent were one of the matters that I inherited. Shortly thereafter, at the request of the inventor and his supervisor, I had to make various changes and additions in the application. I did that, and filed the application for the above patent on February 27, 1987.

5. Thereafter, on May 9, 1988, the above matter was transferred to another attorney, W.G. Montgomery, who then proceeded to respond to the initial office actions in the above prosecution. About April 17, 1989, Mr. Montgomery left Ethyl to take a position with another company, and I inherited the matter a second time. I continued prosecution until the patent issued on March 27, 1990. As noted, I then retired on March 31, 1990.

6. In view of the changes in responsible attorneys and the resulting overloaded docket that I had to carry during the transition periods when Mr. Scherer and Mr. Montgomery left, I now see that several errors occurred in the patent prosecution, and which I will describe below. All the errors occurred without any deceptive intention.

7. The first errors occurred in Claim 36 of the patent application, now claim 1 of the patent. The specification described the useful compounds as $(RO-)_n P(-F)_{3-n}$ where n is 1 or 2, and where R is an aryl group which could have the various defined substituents (see col. 2, lines 1-20). However, in claim 36 (claim 1 of the patent), I limited the aryl group in Formula V to tert-alkyl substituents only, and in Formula VI to only some of the substituents that were described in the disclosure. There was no reason for me to so limit the claim, and I have no recollection of why I so limited the claim. I can only surmise that in the circumstances described above of overloading my docket with the newly inherited cases, I failed to carefully review the draft claim, and overlooked that in the typing, certain substituents had not been typed in.

8. The next error in claim 36 of the application (claim 1 of the patent) was that I failed to account for certain prior art of which I was aware. The circumstances thereof are set forth below.

9. On or about October 8, 1986, I received a memo from the inventor, Dr. Burton, a copy of which is shown to me marked as Attachment A to the Declaration of Lester P.J. Burton. I understood Dr. Burton's memo to mean that his computerized search uncovered only two structures, and that the structures that are followed by "0 ref" meant that the structure was not found in the computerized search. I now understand that my reading of the Burton memo was erroneous, and that all the structures drawn on the memo were found in the prior art but that the then-available

computer report could not cite the references for the structure. I also noted the structures depicted on the two pages of Kosolapoff and Maier, "Organic Phosphorus Compounds", and Attachment A shows my handwriting thereon. With respect to this disclosure, it was my intent to, first, limit the claim 36 to avoid this prior art; and, second, to obtain copies of the references cited in Kosolapoff for submission to the Examiner. Kosolapoff was not a primary disclosure, but a secondary summary of earlier disclosures, and I considered that the primary disclosures would be more pertinent than the secondary reference. I also offered my opinion that patents were far easier to enforce if the most pertinent prior art was submitted to the Examiner, and, therefore, it was my intent to obtain the primary references referred to in Mr. Burton's memo (the computerized search and Kosolapoff), and cite them to the Examiner. Unfortunately, given the overloaded and heavy docket that I was carrying, combined with other work, I inadvertently failed to follow through with my intent. By the time the first Office Action was received, I was no longer involved in the case, and I do not believe that the successor attorney knew of my intent. Finally, by the time I again became involved in the prosecution, more than two years later, I had completely forgotten Dr. Burton's memo and the course that I had intended to follow. At that time, I again was overloaded with the transitional effects of inheriting a leaving attorney's docket. These errors were wholly inadvertent, contrary to my intended course of action, and occurred without any deceptive intention.

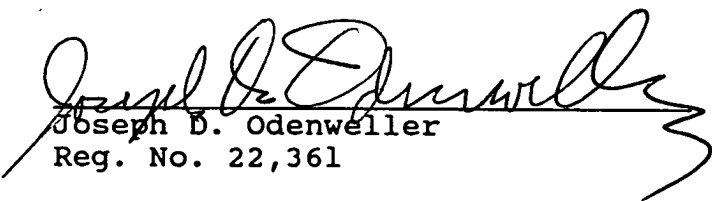
10. A second error occurred which also affected application claim 36 (patent claim 1) and application claim 1 (patent claim 8). Specifically, I am now aware that after the above application was transferred from me to Mr. Montgomery, he filed a European Patent Application on the invention. On July 19, 1988, Ethyl received the results of a European search report, identifying U.S.S.R. Pat. No. 398,574 (Kim), U.S. Pat. No. 3,254,050 (Baranauckas) and U.S. Pat. No. 3,281,506 (Shepard), (a copy of the report and subsequent communications are here included as Attachment B). I note that the communication from the EPO was a simple transmittal of a search report, and there was no EPO Office Action. Although I do not know for a fact as to whether Mr. Montgomery ever saw the report, normal practice would be that foreign search reports were considered only after an office action. From the time I again took over responsibility for the above application on April 17, 1989 and until I retired, I was never aware of the European search report. As shown in Attachment B, Ethyl did receive an EPO office action in the European application on February 6, 1990, but no response was due until, ultimately, July 24, 1990, and I did not consider the EPO matter before I retired.

11. With respect to the EPO report, I note that I had been aware of U.S. Pat. No. 3,281,506 (Shepard) sometime in late 1987, and had disclosed that reference in an Information Disclosure Statement that I filed in connection with patent application Ser. No. 110,181, which I filed October 19, 1987, covering a process of making cyclic aryl chlorophosphites (see Attachment C hereto), but

have no recollection of any relevance of that reference to the application in issue. I further understand that subsequent review of the EPO office action and comparison with the above-identified patent caused the assignee to review the entire application file which has resulted in what I understand to be the present application to reissue.

12. I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that willful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code, and that such willful false statements may jeopardize the validity of the application or any patent issued thereon.

Date: ~~April~~ MAY 7, 1991


Joseph D. Odenweller
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